

## REMARKS

This paper is filed in response to the Office Action mailed December 14, 2009. Claims 1-8, 19 and 21 are pending and claims 10-12, 13-18, and 20 are withdrawn.

### Elections/Restrictions

The Office Action indicates that a restriction is required under PCT Rule 13.1, and has restricted the claims as follows:

Group I, claim(s) 1-8, 19 and 21, drawn to a water borne coating composition.

Group II, claim(s) 10-12, drawn to a method of coating a substrate.

Group III, claim(s) 13, 14, and 20, drawn to a coated substrate.

Group IV, claim(s) 15-18, drawn to the use of inorganic nano-particles.

Applicants provisionally elect claim I with traverse.

As a preliminary matter, Applicants note the International Preliminary Searching Authority did not find a lack of unity of invention in its Written Opinion dated April 1, 2005.

That notwithstanding, Applicants submit that a proper restriction requirement has not been established. When making a lack of unity of invention requirement under PCT Rule 13 (codified in 37 CFR 1.475), “the examiner must (1) list the different groups of claims and (2) explain why each group lacks unity with each other group (i.e., why there is no single general inventive concept) specifically describing the unique special technical feature in each group.” MPEP §1893.03(d).

The Office Action indicates that the shared technical features of the claims of the present application is “a coating composition comprising inorganic nanoparticles in an organic water borne coating composition.” The Office Action then suggests that the Rohrbaugh *et al.* teaches this combination of special features. Without being bound to a full characterization of Rohrbaugh *et al.*, Applicants note that Rohrbaugh *et al.* does not teach a water-borne coating composition as required by the present invention, and as such Rohrbaugh *et al.* does not negate the special technical features claimed in the instant application. Because the Office Action has indicated that all groups share a same set of technical features, and these features are not disclosed in the prior art, the instant Restriction Requirement is improper and should be withdrawn.

Applicants further submit that in order to expedite response to the instant restriction requirement, and in view of the above rendering further argumentation unnecessary, Applicants withhold any further specific response to the Examiner's characterization of the Rohrbaugh et al. (US 2003/0180466). However, Applicants reserve the right to make further distinction of the present claims in view of Rohrbaugh *et al.* at a later time, if necessary.

\*\*\*\*\*

Any extension of time that may be deemed necessary to further the prosecution of this application is hereby requested.

The Commissioner is authorized to charge any additional fees which may be required, or credit any overpayment, to Deposit Account No. 08-3038, referencing the docket number shown above.

Pursuant to MPEP §502.03, authorization is hereby given to the USPTO to communicate with Applicant's representative concerning any subject matter of this application by electronic mail. I understand that a copy of these communications will be made of record in the application file. Applicant's representative, Coraline J. Haitjema, can be reached at email address [haitjemac@howrey.com](mailto:haitjemac@howrey.com).

The Examiner may also contact the undersigned by telephone at the number given below in order to resolve any questions (note, this telephone number is an Amsterdam phone number, Amsterdam time is 6 hours ahead of US east coast time).

Respectfully submitted,

/chaitjema/

Coraline J. Haitjema  
Reg. No. 63,192

Date: 14 January 2010

**Customer No. 32,894**  
Howrey LLP  
2941 Fairview Park Drive, Suite 200  
Falls Church, VA 22042  
Fax: 202 383-7195  
Tel: 9-011-31-20-592-4411